REMARKS

I. Introduction

With the addition of claim 21, claims 1 to 21 are currently pending in this application. Claims 11 to 18 have been withdrawn from consideration. In view of the foregoing amendments and following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

II. Rejection of Claims 1 to 10, 19 and 20 Under 35 U.S.C. § 102 (b)

Claims 1 to 10, 19 and 20 were rejected under 35 U.S.C. § 102 (b) as anticipated by U.S. Patent No. 5,386,973 ("Brenner et al."). Applicant respectfully submits that Brenner et al. do not anticipate claims 1 to 10, 19 and 20 for the following reasons.

Claim 1 relates to a hydraulic bearing. Claim 1 recites that the hydraulic bearing includes a journal bearing and a supporting bearing which are joined by a spring body made of a rubber elastic material and border on at least one working space and at least one compensating space. Claim 1 further recites that the working space and the compensating space are each filled with a damping fluid and communicate through a damping device in a fluid-conducting manner, wherein, in response to relative radial displacement of the journal bearing and the supporting bearing with respect to one another, the damping device has damping fluid flowing through it.

Brenner et al. purportedly relate to an elastomeric bearing. Abstract. Brenner et al. state that the bearing includes at least two fastening parts 7 and 8 connected to one another by means of an elastomer spring 6. Inside the elastomeric bearing at least two damping devices are stated to work essentially independent of one another. See col. 4, lines 4 to 12. The first independent damping device is stated to include chambers 3a and 3b, which are stated to communicate via passage 4. The second independent damping device is stated to include chambers 1a and 1b, which are stated to be separated by partition 10 having passage 2. The first independent damping device is stated to dampen in the radial direction and the second independent damping device is stated to dampen in the longitudinal direction. See col. 4, lines 17 to 40. Accordingly, fluid only flows through partition 10 (damping device) in the second damping device when parts 7 or 8 are excited in a longitudinal direction. Opening 15 is

stated to be provided for pressure equalization between chambers 3a, 3b and chambers 1a, 1b. See col. 10, lines 22 to 26. To achieve a proper pressure equalization, an evacuation hole 14 is stated to be provided in the protective cap 13 to allow atmospheric pressure to act on the external side of chamber 1b. See col. 4, lines 64 to 68. However, Brenner et al. do not disclose, or even suggest, that in response to relative radial displacement of the journal bearing and the supporting bearing with respect to one another, the damping device has damping fluid flowing through it, as recited in claim 1. Therefore, Brenner et al. do not disclose all of the limitations of claim 1.

To anticipate a claim, each and every element as set forth in the claim must be found in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of Calif.*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). That is, the prior art must describe the elements arranged as required by the claims. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). As more fully set forth above, it is respectfully submitted that Brenner et al. do not disclose, or even suggest, a working space and a compensating space that are each filled with a damping fluid and communicate through a damping device in a fluid-conducting manner, wherein, in response to relative radial displacement of the journal bearing and the supporting bearing with respect to one another, the damping device has damping fluid flowing through it, as recited in claim 1. Therefore, it is respectfully submitted that Brenner et al. do not anticipate claim 1.

Additionally, to reject a claim under 35 U.S.C. § 102, the Examiner must demonstrate that each and every claim limitation is contained in a single prior art reference. *See, Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991). Still further, not only must each of the claim limitations be identically disclosed, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the inventions of the rejected claims, as discussed above. *See, Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986). In particular, it is respectfully submitted that, at least for the reasons discussed above, the reference relied upon would not enable a

person having ordinary skill in the art to practice the inventions of the rejected claims, as discussed above.

The Office Action alleges that "Brenner et al. is explicit with respect to the claimed combination," i.e., that "relative radial displacement of Brenner et al.'s journal bearing and supporting bearing with respect to one another results in a pressure differential between the working space and the compensating space which thereby causes a pressure equalization to occur through opening 15 and ultimately, fluid flow through the damping device according to the claimed combination." Office Action at p. 3. However, Brenner et al. only specifically state that opening 15 is provided for pressure equalization between chambers 3a, 3b and chambers 1a, 1b. See col. 10, lines 22 to 26. Respectfully, nowhere does Brenner et al. state, or even suggest, that relative ***radial displacement*** of Brenner et al.'s journal bearing and supporting bearing with respect to one another *necessarily* results in a pressure differential between the working space and the compensating space which *necessarily* causes fluid to flow between these spaces. Relative radial displacement of the journal and supporting bearings may simply cause fluid to shift from cavity 3a to communicating cavity 3b via passage 4, which is larger than opening 15, (see col. 4, lines 23 to 25) and the referred to pressure equalization may only occur, for example, upon relative longitudinal displacement of the bearings or upon opening evacuation hole 14. As indicated above, to achieve a proper pressure equalization, there can be an evacuation hole 14 in the protective cap 13 to thereby allow atmospheric pressure to act on the external side of chamber 1b. See col. 4, lines 64 to 68.

To the extent that the Examiner is relying on the doctrine of inherency, the Examiner must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flows from the teachings of the applied art." *See* M.P.E.P. § 2112; emphasis in original; and *see, Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). The M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic. Nowhere does the Examiner rely on technical reasoning to support its conclusion that fluid necessarily flows between passages 1a and 4 in response to a relative radial displacement of the first and second independent damping devices. As indicated above, Brenner et al. merely disclose pressure equalization through

opening 15 and not, specifically, fluid flow in response to a relative radial displacement of the journal and supporting bearings, as recited in claim 1. See col. 10, lines 22 to 26. Accordingly, the anticipation rejection as to the rejected claims must necessarily fail for the foregoing reasons. Therefore, withdrawal of the 35 U.S.C. § 102(b) rejection and allowance of claim 1 is respectfully requested.

As for claims 2 to 10, 19 and 20 which ultimately depend on claim 1 and therefore include all of the limitations of claim 1, Applicant respectfully submits that these claims are patentable for at least the same reasons provided above in support of the patentability of claim 1. Therefore, withdrawal of the 35 U.S.C. § 102(b) rejection and allowance of claims 2 to 10, 19 and 20 is respectfully requested.

III. New Claim 21

New claim 21 has been added herein. It is respectfully submitted that new claim 21 does not add any new matter and is fully supported by the present application, including the Specification. Because claim 21 contains features analogous to claim 1 it is respectfully submitted that claim 21 is allowable for at least the same reasons submitted above in support of the patentability of claim 1. Further, Applicants respectfully submit that Brenner et al. do not disclose, or even suggest, that the hydraulic bearing is configured such that in response to low-frequency high amplitude vibrations in an axial direction of the hydraulic bearing the damping device (6) has damping fluid flowing through it 180 degrees out of phase with the induced vibrations, as recited in new claim 21.

IV. Conclusion

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

KENYON & KENYON

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By: _____

Abraham P. Ronai
Reg. No. 41,275

One Broadway
New York, New York 10004
(212) 425-7200
CUSTOMER NO. 26646